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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,827	09/29/2003	Mathew R. Roth	0342UR	2524

7590 09/28/2006

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EXAMINER

KOEHLER, CHRISTOPHER M

ART UNIT	PAPER NUMBER
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3726

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/673,827	Applicant(s) ROTH ET AL.	
	Examiner Christopher M. Koehler	Art Unit 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2006.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
 4a) Of the above claim(s) 8-18,23-25 and 30 is/are withdrawn from consideration.
 5) ☒ Claim(s) 26-29 is/are allowed.
 6) ☒ Claim(s) 1-7,19-22 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 8-18, 23-25 and 30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 12/9/2005.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. **Claims 1, 3, 4, 19 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Morford (US Patent No. 6,068,894).**

Claim 1:

Morford teaches a method of manufacturing a leaf display device made of broadleaf stems, each said broadleaf stem comprising a plurality of leaves comprising a first, topmost leaf, a second leaf adjacent said first leaf, and a third leaf adjacent said second leaf, said method comprising the steps of: A. Positioning said first leaf substantially co-linearly with said broadleaf stem; B. Positioning said second leaf over said first leaf; C. Positioning said third leaf over said second leaf; and D. Continuing this positioning process on each successive leaf progressing along said broadleaf stem away from said first leaf until all leaves desired are stacked (**Col. 4 lines 6-29; Figs. 7B and 8B**). Furthermore, Morford teaches that the leaves used are preserved naturally

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occurring leaves and that untreated and unpreserved, therefore purely naturally occurring, leaves may also be used in the same process (**col. 3, lines 43-59**).

Claim 3:

Morford also teaches the method of claim 1 wherein a width of said stacked broadleaf stem is substantially equal to twice an average width of the leaves comprising said finished stacked broadleaf stem (**Fig. 7B**).

Claim 4:

Morford also teaches the method of claim 3 as described above, further comprising the step of removing a top portion of a broadleaf stem as necessary to provide a single leaf emerging from a top of the stem. "As necessary" implies that no leaves could be removed. As shown in **Fig. 4**, a single leaf emerges from a top of the stem.

Claim 19:

Morford teaches a method of manufacturing a leaf display device comprising the steps of: A. Positioning a top leaf on a broadleaf stem substantially co-linear with said broadleaf stem; B. Positioning a leaf adjacent said top leaf substantially parallel to, and partially on top of said top leaf; C. Positioning a leaf adjacent the leaves already stacked substantially parallel to, and partially on top of the previously stacked leaves; and D. Repeating the previous step until all leaves desired to be stacked have been stacked (**Col. 4 lines 6-29; Figs. 7B and 8B**). Furthermore, Morford teaches that the leaves used are preserved naturally occurring leaves and that untreated and unpreserved,

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therefore purely naturally occurring, leaves may also be used in the same process (**col. 3, lines 43-59**).

Claim 21:

Morford also teaches the method of claim 19 wherein a width of said stacked broadleaf stem is substantially equal to twice an average width of the leaves comprising said finished stacked broadleaf stem (**Fig. 7B**).

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. **Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being obvious over Morford.**

6. Morford teaches the invention cited with the exception of trimming lower portion leaves and trimming the stem. However, it was well known to a person of ordinary skill in the art at the time of invention to trim a lower leaf and stem portion in order to remove dead leaves and in order to shorten the length of the stem. Since applicant failed to traverse the examiner's taking of official notice in the first office action, applicant is considered to have concurred with the examiner that this trimming step was well known in the art prior to applicant's invention. Thus, it would have been obvious to one of ordinary skill in the art to have performed the claimed trimming step for aesthetic purposes.

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7. Claims 2 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morford (U.S. Patent No. 6,068,894) in view of Higdon et. al. (U.S. Patent No. 4,011,677).

8. Morford teaches the methods of claims 1 and 19 as described above but does not teach the method comprising the further step of selecting which surface of each said leaf should be visible when viewed from a visible side of the stacked broadleaf stem, said visible side of said stacked broadleaf stem being a side of said broadleaf stem upon which said last leaf was stacked.

9. Higdon teaches the method of selecting which surface of each said leaf should be visible when viewed from a visible side of the stacked broadleaf stem, said visible side of said stacked broadleaf stem being a side of said broadleaf stem upon which said last leaf was stacked **(Col. 3 lines 45-55)** for the purpose of accomplishing a desirable appearance.

10. It would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated the appearance selection method of Higdon with the method of Morford for the purpose of accomplishing a desirable appearance in a leaf display device.

11. Claim 7 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morford (U.S. Patent No. 6,068,894) in view of Li (U.S. Patent No. 5,759,645).

12. Morford teaches the methods of claims 1 and 19 as described above but fails to specifically teach the method comprising the further step of attaching one or more of said stacked broadleaf stems to a leaf display device frame.

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13. Li teaches the method of attaching one or more stacked broadleaf stems **70** to a leaf display device frame **94** for the purpose of displaying leaves (**Col. 1 lines 14-53**).

14. It would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated the display device frame for the purpose of displaying one or more broadleaf stems.

Allowable Subject Matter

15. Claims 26-29 are allowed.

Response to Arguments

16. Applicant's arguments with respect to claims 1-7 and 19-22 have been considered but are moot in view of the new ground(s) of rejection.

17. The declaration under 37 CFR 1.132 filed 7/3/2006 is insufficient to overcome the rejection of claims 1-7 and 19-22 based upon the anticipation of the Morford reference as set forth in the last Office action because:

a. Declarations made under 37 CFR 1.132 are not sufficient to overcome rejections under 35 USC § 102.

b. An affidavit or declaration attributing commercial success to a product or process "constructed according to the disclosure and claims of [the] patent application" or other equivalent language does not establish a nexus between the claimed invention and the commercial success because there is no evidence that the product or process which has been sold corresponds to the claimed invention, or that whatever commercial success may have occurred is attributable to the product or process defined by the claims. *Ex parte Standish*,

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10 USPQ2d 1454, 1458 (BPAI 1988). See MPEP 716.03(a), section I, paragraph 2.

18. Applicants arguments pertaining to secondary considerations in light of the declaration are considered moot in light of the ineffectiveness of the declaration and the anticipatory, i.e. not obviousness type, rejection applied to the claims above.

Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Koehler whose telephone number is (571) 272-3560. The examiner can normally be reached on Mon.-Fri. 7:30A-4:00P.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CMK



DAVID P. BRYANT
SUPERVISORY PATENT EXAMINER

9/21/06